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Due Date: November 15, 2006

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Ronald P. Cocchi et al.	Examiner:	Matthew E. Henghan
Serial No.:	10/085,860	Group Art Unit:	2134
Filed:	February 28, 2002	Docket:	PD-201161
Title:	ASYNCHRONOUS CONFIGURATION		

## CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8

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By: Georgina S. Grunebach, Registration No. 33,179

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PRE-APPEAL BRIEF REQUEST FOR REVIEW ARGUMENTS

**MAIL STOP AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action dated August 15, 2006, and the Advisory Action dated October 27, 2006, Appellant hereby submits a Notice of Appeal accompanied by a Pre-Appeal Brief Request for Review.

In the final Office Action, claims 12, 13, 27, 28, 42, 43, 57, and 58 were rejected under 35 U.S.C. §112 first paragraph, as failing to comply with the enablement requirement.

Claims 12, 13, 27, 28, 42, 43, 57, and 58 were rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections.

Claims 15, 17-19, 21-24, 30-34, 36-39, 45, 47-49, and 51-54 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,035,038 to Campinos et al.

Claims 1-10, 12, 15, 17-25, 27, 30-40, 42, 45, 47-55, and 57 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,157,719 to Wasilewski et al. in view of Campinos.

Claims 13, 28, 43, and 58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wasilewski in view of Campinos and further in view of U.S. Patent No. 5,222,141 to Killian.

Claims 14, 29, 44, and 59 were merely objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In response to the final Office Action, Appellants amended the independent claims to incorporate the limitations of the objected claims. Further, arguments were made to overcome the 112 based rejections.

In response, the Advisory Action entered the amendments and indicated that all of the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 were overcome. The Advisory Action further maintains the rejections under 35 U.S.C. §112, first paragraph relating to non-enablement. It is unclear from the Advisory Action if the 35 U.S.C. §112, second paragraph rejections are being maintained or if Appellants have overcome the rejections.

Appellants respectfully traverse the rejections and submit that there are clear errors in the Examiner's rejection and the Examiner has omitted an essential element needed to establish a prima facie rejection.

Specifically, Appellants direct the attention of the panel to pages 10-13 of the response to the final rejection filed on August 15, 2006. Therein, Appellants addressed the enablement aspects of the invention with respect to the use of multiplexors. In addition, Appellants directed the attention of the Examiner to multiple different definitions of a multiplexor from various sources. Such definitions were not needed nor used to establish the prior art. Accordingly, there was no need to enter the citation into the record. Rather, the definitions were merely used to indicate to the Examiner that the use of a multiplexor was in contrast to the definition used and asserted by the Examiner in this matter. Further, the definitions were used to establish that multiplexors in general are known in the art and their use need not be described in specific detail in a specification in order to enable the invention.

It is the Examiner's obligation to set forth a prima facie rejection. The Examiner has failed to establish that the use of multiplexors in the manner claimed, are not enabled by the specification.

In the Advisory Action, the Examiner asserts:

Applicant's arguments do not refute the case that Applicant's specification simply states that the invention connects multiplexers using 'custom logic' (see paragraph 70), without suggesting what that logic is.

Appellants respectfully disagree and traverse such an assertion. Appellants have referred multiple times to paragraphs [0070]-[0074] of the specification which clearly establish and describe how multiplexors are used. Paragraph [0071] describes the custom logic that utilizes a key that defines a configuration for permutations. Paragraphs [0072]-[0074] further describe such permutations. Again, as stated in the previously submitted arguments, the present claims do not recite nor specify that the same number of inputs or outputs are used. Instead, the claims provide for using a series of configurable multiplexors based on the key. Since the multiplexors are configurable, the key may be used to dynamically configure the various components of the invention. Such a use clearly establishes how the multiplexors relate to the invention and how they are used.

In rejecting the claims, the Examiner is ignoring these paragraphs (i.e., paragraphs [0070]-[0074]) from the specification thereby establishing an omission of an essential element needed for a *prima facie* rejection under 35 U.S.C. §112 and resulting in clear error in the rejection.

In addition, the Examiner has indicated that U.S. Patent No. 5,867,644 is used for a different purpose from that of the present invention and therefore cannot be used to provide enabling support. Appellants note that the '644 reference was merely provided to make clear to the Examiner that configurable multiplexors are known in the art. The particular manner in which a multiplexor is configured is set forth in the present invention and claims. Accordingly, the end use for which the Examiner is relying has no relevance with respect to the present invention. Further, for 112 support, the field of invention is not particularly relevant. In this regard, the standard for determining whether an invention is enabled is whether the experimentation needed to practice the invention is undue or unreasonable (see MPEP 2164). Here, any person of ordinary skill in the art would know that multiplexors can be configurable. Accordingly, to argue that multiplexors cannot be configurable is wholly without merit and ignoring the clear standards set forth in the case law and MPEP.

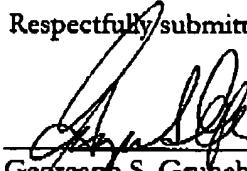
Again, the specification clearly establishes and describes how multiplexors are connected and used. Namely, a permutation (which is defined using a key) employs a series of configurable

multiplexors. The configurable multiplexors are used at the beginning and end of a hardware state machine. Again, the specification explicitly describes that a key is used to define the configuration for the multiplexors.

Such a citation and description in the specification clearly provides sufficient support under 35 U.S.C. §112. To fail to consider such a teaching establishes clear error in the Examiner's rejection and fails to consider an essential element needed for a 112 based rejection.

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Appellant's undersigned attorney.

Respectfully submitted,



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Date: November 9, 2006

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